

Appl. No. 09/766,616
Amdt. Dated May 25, 2004
Reply to Office action of February 26, 2004
Attorney Docket No. P13207-US2
EUS/J/P/04-2004

REMARKS/ARGUMENTS

1.) Amendments

The Applicants have cancelled claims 29-36. Claims 1-10, 13-24 and 27-28 remain pending in the application. Favorable reconsideration is requested in view of the foregoing amendments and the following remarks.

2.) Claim Rejections – 35 U.S.C. §102

The Examiner rejected claims 1-10, 13-24 and 27-36¹ as being unpatentable over Bloebaum *et al.* (US 6,204,808). The Applicants traverse the rejection.

The Examiner, having previously allowed the pending claims, has now rejected the claims as being anticipated by Bloebaum. For Bloebaum to anticipate the claimed invention, it must not merely approximate or be almost the same as the invention, but there must be an identity of invention between it and the claim. Anticipation requires the presence in the Bloebaum disclosure of all elements of the claimed invention arranged as in the claim. The claim limitations which must be met are those set forth in each element, and such a limitation cannot be met by an element in Bloebaum that performs a different function, even though it may be part of a device embodying the same general overall concept. See, *RCA Corp. v. Applied Digital Data Sys., Inc.* 221 USPQ 385, 389 n.5 (Fed. Cir. 1984).

Applicant's invention is directed to systems and methods for adjusting the clock of a base transceiver station. In contrast, Bloebaum is directed to a method of

¹ Claims 29-36 have been cancelled.

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determining the geographic location of a mobile station. (Column 3, lines 62-63.) Some of the limitations of claim 1 include functionality that is dependent upon prior claim limitations. Although claim 1 contain terms which the Examiner has related to similar terms distributed throughout Bloebaum, the functionality embodied by the limitations of the claim, taken as a whole, is not disclosed by Bloebaum. This is apparent by noting that the Examiner's references to portions of Bloebaum for each claim limitation are not ordered sequentially, but are taken from random portions of Bloebaum. The Examiner has based the rejection on apparently similar terms used in Bloebaum, without taking into consideration the invention as a whole. As noted previously, the claim limitations which must be met are those set forth in each element, and such limitations cannot be met by an element in Bloebaum that performs a different function, even though it may be part of a device embodying the same general overall concept. Whereas the Examiner has failed to consider the functionality of each claim limitation, and the relation of each limitation to the invention as a whole, the Examiner has not established that Bloebaum anticipates claim 1. Accordingly, Bloebaum fails to anticipate claim 1.

Whereas claim 15 recites limitations analogous to claim 1, that claim is also not anticipated by Bloebaum. Furthermore, whereas claims 1-10 and 13-14 are dependent from claim 1 and claims 16-24 and 27-28 are dependent from claim 15, and include the limitations thereof, those claims are also not anticipated by Bloebaum. The Applicants, therefore, respectfully request that the Examiner withdraw the rejection and issue a Notice of Allowance for claims 1-10, 13-24 and 27-28.

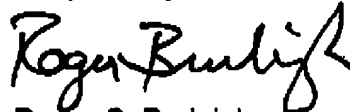
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CONCLUSION

In view of the foregoing remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 1-10, 13-24 and 27-28.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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